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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,284	08/01/2003	James M. Tour	11321-P022WUD3	5081

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EXAMINER

SELLERS, ROBERT E

ART UNIT PAPER NUMBER

1712

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,284

Applicant(s)

TOUR ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 97-123 and 130-133 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 97-123 and 130-133 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The application has been transferred due to the election of Group I, claims 97-123 and 130-133, directed to a method of making a polymer material and the polymer material, and the cancellation of non-elected claims 124-129 in the election filed July 12, 2006. However, due to the unfamiliarity of the previous examiner with the elected subject matter, the following further restriction and election of species are advanced.

1. The specification is required to disclose the relationship as a divisional of application no. 10/470,517 filed July 29, 2003 along with its pending status.
2. The status of application no. 09/830,842 mentioned on page 6, lines 2-4 of the specification as abandoned should be included.
3. There is no description on page 9, lines 6-32 of the specification pertaining to thermosetting (i.e. curable) resins of the species of curing agent of claim 120. The species should be inserted into the specification for proper support.

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4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 97-109, drawn to a method for making a polymer material, classified in class 524, subclass 584.
- II. Claims 110 and 130, drawn to a method for making a polymer material further comprising curing the polymer material, classified in class 523, subclass 468.
- III. Claims 111-123 and 131-133, drawn to a polymer material, classified in class 524, subclass 612.

The inventions are independent or distinct from each other because:

5. Inventions (I or II) and III are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another materially different product or

(2) the product as claimed can be made by another materially different process

(MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make another materially different product such as derivatizing a different filler such as silica and dispersing it in a polymer.

6. The further curing step in the method of Group II constitutes a materially different manipulation of the polymer material from the mere dispersing of Group I which irreversibly alters the chemical structure of the polymer material, rendering it distinct from the mere non-reacted dispersion.

Restriction for examination purposes as indicated is proper because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification.

7. This application contains claims directed to the following patentably distinct species:

a) The polymers wherein a single species is selected from among the polyethylene, polypropylene, epoxy resins or polycarbonate described on page 3, line 35 of the specification.

b) The derivatized carbon nanotubes wherein the the functional moieties are either:

i) Chemically bound to the polymer as defined in claim 99 or 115, wherein the type of functional moieties are specified, such as the selection of a single species of diazonium salt from Figure 1 as described on page 6, line 37 to page 7, line 5.

ii) Not chemically bound to the polymer as denoted in claim 110 or 116, wherein the type of functional moieties are specified, such as the selection of a single species of diazonium salt from Figure 1 as described on page 6, line 37 to page 7, line 5.

iii) Removed as set forth in claim 101, wherein the type of functional moieties are specified, such as the selection of a single species of diazonium salt from Figure 1 as described on page 6, line 37 to page 7, line 5.

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c) Contingent upon the election of Group II or III, items a) and b) hereinabove and the curing agents (if elected to be present in Group III) such as a single species chosen from claim 107.

8. The species are independent or distinct because the various types of polymers requires burdensome searches throughout classes 523 and 524.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species ***within items a), b), and c) if appropriate***, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Currently, claims 97-123 and 130-133 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

(MPEP § 809.02(a)).

The reply to this requirement to be complete must include (i) an election of an invention and species to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention and species.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case.

In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application.

Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Monday to Friday, 9:30 to 6:00
rs
8/17/2006



ROBERT E.L. SELLERS
PRIMARY EXAMINER